



PATENT
Attorney Docket No. 10791.0001-00-000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Richard S. Belliveau) Group Art Unit: 2875
)
Application No.: 10/801,177) Examiner: Lee, Y MY Quach
)
Filed: March 15, 20004)
)
For: Lighting Devices Using a Plurality of)
Light Sources)

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant presents this Reply to the Examiner's Answer dated October 22, 2009. A Request for Oral Hearing is concurrently filed with this Reply Brief.

An **Argument** in reply to the Examiner's Answer follows on the next page of this paper.

I. ARGUMENT

A. Introduction

In response to Appellant's Appeal Brief filed July 21, 2008, and November 21, 2008 ("Opening Brief"), the Examiner maintains the position that claims 1-82 are based upon a defective reissue oath or declaration under 35 U.S.C. § 251 for lack of error. (See Examiner's Answer at 5.) Appellant respectfully traverses this rejection. The Examiner's Answer is conspicuous in its failure to respond meaningfully to numerous points raised in Appellant's Opening Brief. Appellant made the following arguments in its Opening Brief that the Examiner's Answer simply fails to address:

- During the original prosecution of the present reissue application, the Examiner relied on the *figures* of the application as the basis for the restriction requirement and the Examiner included Figure 3F (which the Examiner concedes illustrates discrete circuits for individually controlling the wavelength intensity of light sources) in Elected Group 1 (Opening Brief at 11, 29-31);
- Reissue claims 13-77 and 79-82 were not presented in Appellant's original application and no restriction requirement was issued with respect to these claims (Opening Brief at 37);
- Reissue claims 13-77 and 79-82 are substantially different from, and contain significant additional limitations not present in, the non-elected claims of the original prosecution (Opening Brief at 16-25, 36-37);
- Under the court's holding in *In re Doyle*, 293 F.3d 1355, 1361 (Fed. Cir. 2002), an applicant is not precluded from presenting reissue claims merely because the

claims *read on* subject matter of non-elected groups; instead, the relevant inquiry is whether the reissue claims could have been prosecuted alongside the elected claims in the original prosecution (Opening Brief at 32);

- The concept of a “linking claim,” as recognized by both MPEP § 809 and *In re Brouwer*, 175 F.2d 564, 568 (CCPA 1949), is broader than the genus-type claims at issue in *Doyle*, and extends to hybrid claims that cover subject matter from elected and non-elected groups (Opening Brief at 38-39); and
- An applicant is entitled to prosecute claims of the elected group as well as linking claims that cover subject matter from both elected and non-elected groups (Opening Brief at 39).

B. Reissue Claims 13-77 and 79-82 Are Linking Claims Covering Subject matter from Elected Group 1 and at Least One of Non-Elected Groups 2-4

Under *Doyle*, the failure to prosecute claims following issuance of a restriction requirement is an error correctable by reissue if (1) the claims are substantially different from the non-elected claims of the original prosecution; and (2) the reissue claims could have been prosecuted alongside the claims of the elected group. *Doyle*, 293 F.3d at 1361. In this case, the requirements of *Doyle* are met. First, the Examiner does not dispute that reissue claims 13-77 and 79-82 contain significant additional limitations not present in the non-elected claims that were cancelled during the original prosecution. Second, the Examiner concedes that Figure 3F of Elected Group 1 discloses a multi-parameter light with “discrete circuits for individually controlling light source intensity.” (Examiner’s Answer at 3.) Because reissue claims 13-77 and 79-82 cover this subject matter, in addition to subject matter from at least one of Non-Elected Groups 2-4, these claims are linking claims. See MPEP § 809; *Brouwer*, 175 F.2d at 568.

According to the Examiner, “the subject matter of individual [sic] controllable wavelength light intensity was restricted in the original prosecution application because this subject matter was directed to non elected embodiments 3D and/or 3E.” (Examiner’s Answer at 7.) The Examiner’s position is inconsistent with the Examiner’s reliance during the original prosecution on the *figures* of the application as the basis for the restriction requirement. The Examiner included Figure 3F (which discloses discrete circuits for individually controlling wavelength intensity) in Elected Group 1. Thus, during the original prosecution, the Examiner considered pending claims 19-20, 33-36, 37, 39-40, 43, and 49 to be directed to non-elected subject matter on the basis that these claims contained at least one additional limitation illustrated in a Figure of Non-Elected Groups 2, 3, or 4, and *not* on the basis that they contained subject matter directed to LEDs with individually controllable wavelength intensity. (*See also* Opening Brief at 11-13, 29.)

Throughout the Examiner’s Answer, the Examiner incorrectly assumes that simply because a claim contains *additional* limitations above and beyond “discrete circuits for individually controlling light source intensity” that claim cannot be directed to the subject matter of Figure 3F. The Examiner misses the point. In this case, pending reissue claims 13-77 and 79-82 are linking claims precisely because they cover the subject matter of Figure 3F of Elected Group 1 in addition to subject matter from one of Non-Elected Groups 2-4. *Doyle* made clear that a reissue claim is not improper merely because it reads on subject matter of non-elected claims. 293 F.3d at 1361. Instead, the relevant inquiry is whether the reissue claims are substantially different from the non-elected claims. *Id.* In this case, it is undisputed that reissue claims 13-77 and 79-82 contain significant additional limitations not present in the non-elected

claims (Opening Brief at 16-25, 36-37) and thus reissue claims 13-77 and 79-82 are substantially different from the claims of Non-Elected Groups 2-4.

In this case, reissue claims 13-77 and 79-82 cover subject matter disclosed in Figure 3F (i.e., discrete circuits for individually controlling the light source intensity) in combination with Figures 3D, Figure 3E or other subject matter of Non-Elected Groups 2-4. (*See also* Opening Brief at 15-25, 27-28.) For example, reissue claim 33 claims:

33. A lighting apparatus for projecting light onto a surface comprising:
- a substrate;
 - a first housing, in which the substrate is located;
 - a plurality of light emitting diodes comprised of a first portion and a second portion each of the first and second portion emitting light having an intensity;
 - a variable filter;
 - a lamp driver;
 - a communications component;
 - wherein the substrate has a first circuit and a second circuit;
 - wherein the lamp driver circuit is electrically connected to the first circuit and the second circuit;
 - wherein the first portion of the plurality of light emitting diodes are connected to the first circuit and the first circuit can vary the intensity of the light emitted by the first portion of the plurality of light emitting diodes;**
 - wherein the second portion of the plurality of light emitting diodes are connected to the second circuit and the second circuit can vary the intensity of the light emitted by the second portion of the plurality of light emitting diodes;**
 - wherein the first portion of the plurality of light emitting diodes emits light of a first color and the second portion of the plurality of light emitting diodes emits light of a second color different from the first color;

wherein the light emitted from the first portion and the second portion of the plurality of light emitting diodes is emitted through the variable filter; and

wherein the communications component can receive a control command for varying control information to the variable filter.

As shown in bold above, reissue claim 33 covers subject matter from Elected Group 1 (i.e., discrete circuits which allow for varying the intensity of individual LEDs or different portions of LEDs). In addition, claim 33 covers subject matter from Non-Elected Group 4 (i.e., lamp driver circuit, processor, and variable filter). (See Opening Brief at 18-19.) Contrary to the Examiner's assertion, reissue claim 33 does *not* cover subject matter from only Non-Elected Groups 2 or 3 for the reasons stated above. A similar analysis can be applied to each of reissue claims 13-77 and 79-83.

The MPEP and courts have recognized that the concept of a linking claim is broader than the genus-type linking claims at issue in *Doyle*. (See MPEP § 809; *In re Brouwer*, 175 F.2d at 568; Opening Brief at 38-39). Claims that tie together the elected and non-elected groups are linking claims irrespective of whether they are broad genus claims or narrower hybrid claims. *Id.* The Examiner does not dispute Appellant's interpretation of this authority. Thus, Reissue claims 13-77 and 79-83 could have been prosecuted along with the elected claims in the original application because they are linking claims that cover subject matter from Elected Group 1 and at least one of non-Elected Groups 2-4.

C. No Formal Restriction Requirement Was Issued With Respect to the Pending Reissue Claims

It is undisputed that no formal restriction requirement was issued with respect to the pending reissue claims. The Examiner asserts, however, that "if these added reissue claims were presented during the prosecution of the '499 application, these claims would have been restricted out as being directed to an invention that is patentably distinct from the elected invention, and

these claims would have been withdrawn from consideration.” (Examiner’s Answer at 8.) The Examiner provides no basis for this statement. In the past, courts have declined to extend any “mechanical rule” against reissue when no formal restriction requirement was made. *See In re Swartzel*, 1995 U.S. App. LEXIS 15992, *5-6 (Fed. Cir. 1995) (non-precedential) (“[W]e decline to extend any mechanical rule against reissue where the PTO’s actions are only ‘tantamount’ to a restriction requirement.”); *Ex Parte Okamoto*, Appeal No. 2000-0132 (available at 2006 WL 2523548, *3) (Bd. Pat. App. Oct. 12, 2002) (“In the present case, no formal restriction requirement of claims drawn to a combination of a separating agent and a chromatographic column was ever imposed by the examiner, or acquiesced by the appellants, since they were not presented in the appellants’ original application. Thus, it cannot be argued that the appellants’ failure to file a divisional application to such subject matter was a deliberate act and not an error under Section 251.”).

If the pending reissue claims are indeed directed to a separate and distinct invention, the Examiner is free to issue a restriction requirement between the originally issued patent claims 1-12 and the reissue claims. The original patent claims will then be held to be constructively elected, while the non-elected, newly added reissue claims are held in abeyance in a withdrawn status and only examined if filed in a divisional reissue application pursuant to 37 C.F.R.

§ 1.177. (See Opening Brief at 40-41.)

D. The Holding of *Doyle* Applies to Linking Claims Irrespective of Whether They are Broad Genus Claims or Narrower Hybrid Claims

The Examiner’s Answer alleges that the requirements of *Doyle* are not met because “MPEP 1412.01 Page 1400-14 August 2005 states that a *linking claim*, according to *In Re Doyle*, is a claim broad enough to read on the invention elected (*and patented*) together with the invention not elected.” (Examiner’s Answer at 6.) The Examiner has cited no support for

limiting *Doyle* to genus-type linking claims, and, indeed, that view is inconsistent with the decision of the Court of Customs and Patent Appeals in *Brouwer*, 175 F.2d at 568. The Court's holding in *Doyle* did not rest on the fact that Dr. Doyle's claims were a *particular* type of linking claim, but on the fact that because the claims were linking claims Dr. Doyle could have prosecuted his reissue claims alongside the claims of the elected group. 293 F.3d at 1360 (a "critical and indeed dispositive difference between the present case and *In re Orita*" was that "Dr. Doyle could have prosecuted his reissue claims with the claims of the elected group."). MPEP § 809 applies with equal force to the linking claims at issue in the present case and states that "linking claims must be examined with, and thus are considered part of, the invention elected." Accordingly, under the Court's holding in *Doyle*, the pending reissue claims are the proper subject of a reissue application because they are linking claims that could have been prosecuted along with the claims of Elected Group 1 in the original prosecution.

E. Reissue Claim 78 Covers Subject Matter from Elected Group 1 and Is Therefore the Proper Subject of a Reissue Application

The Examiner does not dispute that claim 78 is directed to a multi-parameter light with discrete circuits for individually controlling light source intensity (as disclosed in Figure 3F of Elected Group 1). The Examiner contends, however, that claim 78 cannot read on the embodiment of Figure 3F because it contains additional limitations. In particular, the Examiner contends that Figure 3F "does not disclose that the light emitting diodes emit light of first, second, third, fourth and fifth wavelengths, respectively and that these first, second, third, fourth, and fifth wavelengths produce respectively different colors." (Examiner's Answer at 9.) According to the Examiner, "individual or different wavelength light sources controlled intensity is fully described in the nonelected embodiments of figures 3D and 3E." (*Id.* at 10.)

Contrary to the Examiner's assertion, the specification of the '893 patent makes clear that the embodiment disclosed in Figure 3F is *not limited* to light sources of a particular color distribution. For example, the specification explains that Figure 3F's discrete circuits for individually controlling light source intensity "could be an advantage when providing control access to *multi color systems* or different intensity levels of each specific color." ('893 patent, col. 11, ll. 3-6 (emphasis added).) Consistent with this interpretation, the specification also explains that the discrete electronic circuits of Figure 3F can be used in conjunction with the light sources arranged in the *specific color distributions* disclosed in Figure 3D. (E.g., *id.*, col. 11, ll. 50-53.)

Moreover, as explained in Appellant's Opening Brief, Figure 3D (of Non-Elected Group 2) and Figure 3E (of Non-Elected Group 3) by themselves disclose embodiments with light sources in *specific color distributions*. (Opening Brief at 14.) In particular, Figure 3D discloses by itself a plurality of light sources arranged in a "multi wavelength distribution pattern" that includes red, green, and blue light sources, and possibly a white light source. ('893 patent, col. 11, ll. 34-40.) Figure 3E by itself discloses a plurality of light sources that are primarily white continuous spectrum LEDs. (*Id.*, col. 12, ll. 32-53.)

Thus, reissue claim 78 is directed to the embodiment illustrated in Figure 3F in which there are discrete circuits which allow for varying the intensity of individual LEDs or different portions of LEDs. ('893 patent, col. 10, l. 65-col. 11, l. 9.) Reissue claim 78 is not directed to the particular embodiments disclosed in either Figure 3D or Figure 3E. Thus, reissue claim 78 could have been prosecuted along with the elected claims in the original application.

II. CONCLUSION

For the reasons given above, and in Appellant's Appeal Brief filed on July 21, 2008 and November 21, 2008, Appellant respectfully requests that the Board reverse the rejection of claims 1-82.

Please charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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